

Notice of Allowability

Application No.

10/722,702

Examiner

Devesh Khare

Applicant(s)

ELZEIN ET AL.

Art Unit

1623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 9/14/2006.
2. ☒ The allowed claim(s) is/are 1-3,6-23 and 27.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO/SB/08),
Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application
6. ☒ Interview Summary (PTO-413),
Paper No./Mail Date 11/21/2006.
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____


SHAOJIA ANNA JIANG, PH.D.
SUPERVISORY PATENT EXAMINER

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A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office Action has been withdrawn pursuant to 37 CFR 1.114.

The amendments and remarks received on 09/14/2006 have been entered. Claims 1, 2, 3, 11-16, 20 and 22 have been amended. Claims 4 and 5 have been cancelled. Claims 24-26 and 28-33 have been cancelled previously.

The rejection under 35 U.S.C. 112, second paragraph, of the office action dated 05/16/2006 has been withdrawn in response to the applicant's amendments dated 09/14/2006.

The rejection under obviousness-type double patenting, of the office action dated 05/16/2006 has been withdrawn in response to the applicant's remarks that instant compounds are not obvious over the compounds of Zablocki (cited U.S. Patents) and Klotz et al. because there is nothing in that disclosure that would lead one of ordinary skill in the art that replacing the 6-amino group of Zablocki with a 6-substituted amino group would be obvious and would change the properties of such compounds from A_{2A} adenosine receptor agonists to A₃ adenosine receptor antagonists.

1. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given by Brian Lewis on 11/21/06.

Claim 13 depends on claim 3.

Claims 1-3, 6-23 and 27 are currently pending in this application.

Claims 1-3, 6-23 and 27 are allowed.

2. The following is an examiner's statement of reasons for allowance: The instant invention is directed to a compound of the formula I (adenosine prodrug, claim 1) wherein C-2 is substituted pyrazolyl or substituted triple bond ($-C\equiv C-$) and C-6 is a substituted amino group and a pharmaceutical composition thereof, is not taught or fairly suggested by the prior art.

The most relevant reference discovered includes Zablocki et al. (claims 1-28 of U.S. Patent No. 6,214,807; claim 1 of U.S. Patent 6,855,818; and claims 1,5 and 6 of U.S. Patent 6,770,634).

Zablocki et al's. patents disclose and claim A_{2A} adenosine receptor agonists, and there is nothing in that disclosure that would lead one of ordinary skill in the art that replacing the 6-amino group of Zablocki with a 6-substituted amino group would be obvious and would change the properties of such compounds from A_{2A} adenosine receptor agonists to A_3 adenosine receptor antagonists, so no anticipatory or obviousness rejection can be applied.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Devesh Khare, Ph.D., J.D.
Art Unit 1623
November 21, 2006



Anna Jiang, Ph.D.

Supervisory Patent Examiner
Technology Center 1600